

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claims 1-32 are cancelled above. New claims 33-58 are submitted.

These claims cancellations and the submission of new claims are made to simplify the prosecution of this application. While Applicant does not agree with the Examiner's rejections in the prior Office Action, Applicant has submitted new claims to eliminate prior art issues raised by the Examiner in order to enable rapid allowance of the claims.

New independent claims 33 and 56 specify that the composition contains from 85 to 98% propylene carbonate. Support for this range is provided in the specification, for example, at p.5, lines 7-11, and therefore, by arithmetic difference, also provides the upper range of 15% for the water component, which could otherwise range from 1.5% to 25% (e.g., p.4, line 11). Support for LVP-VOC and LR-VOC is provided in the specification, for example, at p.15, line 30 to p.16, line 10. Support for absence of peroxide in claim 33 is provided in the specification at p.9, lines 32-33. Support for the optional inclusion of a preservative agent, a thickener, a humectant, a glycol, and/or glycerol in claim 56 is provided in the specification, for example at p.5, line 15 to p.6, line 22.

Support for the term "consisting essentially of" in claims 34-37 is provided by the specification at p.27, lines 29-32. Support for LVP-VOC in claim 38 is provided at p.15, line 30 to p.16, line 10 as indicated above. Support for the range of 85% to 90 propylene carbonate in claim 39 is provided in the specification, for example, at p.5, line 10. Support for the limitations of claims 40 and 41 is provided in the original claims as well as in the specification. Support for claims 42 and 43 is provided in the specification at p.7, lines 30-31. Support for claims 44-48 is provided in the original claims as well as in the specification. Support for claims 49-54 is provided in original claims 22-25 as well as in the specification at p.7, lines 1-17. Support for

claim 55 is provided in the specification at p.9, line 33. Support for the range of glycerol inclusion in claims 57 and 58 is provided in the specification, for example, at p.6, lines 21-22. Support for the range of glycol inclusion in claims 57 and 58 is provided by the specification, fore example at p.6, lines 1-2, in conjunction with the arithmetic difference where the propylene carbonate and water together constitute at least 86.5% of the composition. Thus, the new claims presented above do not introduce any new matter.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 33-58 are now pending in this application.

Before addressing the Examiner's rejections, Applicant requests that the Examiner note that this invention has only a single inventor. Therefore, the reference to multiple inventors on p.3, item 5 of the outstanding Office Action is inapplicable to the present application, and Applicant respectfully requests that it be removed from any possible future Office Action.

Also, before addressing the Examiner's rejections, Applicant requests that the Examiner note the changes in the present claims. The present claims are directed to a novel nail polish remover that contains at least 85% of the particular solvent, propylene carbonate, contains at least 1.5% water, and that is pH buffered to a slightly acidic range of pH 2.0-6.0, and more preferably to a pH around 4.0. A notable advantage of having the pH buffered to this range is that the stability of the nail polish remover is greatly enhanced when the nail polish remover is used with a reusable applicator. In addition, any additional organic co-solvents are either low vapor pressure volatile organic compounds, or low reactivity volatile organic compounds.

In view of those characteristics, the present compositions are highly advantageous nail polish removers, and are distinguished from the several references cited by the Examiner as allegedly anticipating or making obvious the previous claims.

In addition to the distinctions specified by claim 1, Applicant notes that claims 49-54 concern nail polish remover in a container with a reusable applicator. Inclusion of such a reusable applicator further distinguishes those claims from the references cited by the Examiner in the rejections (discussed below), and has not been previously addressed.

Rejections under 35 USC §§ 102 and 103

The Examiner rejected claims 1-2, 5-7, and 9-26 under 35 USC §102(b), or alternatively under §103(a) as allegedly being anticipated by, or obvious over Elepano et al. U.S. Pat. 4,508,634. The Examiner asserted that “As this reference teaches all of the instantly required, it is considered anticipatory.” The Examiner further asserted that, in the alternative, “It would have been inherent to the compositions of Elepano et al to comprise a composition within the pH limitations of the claimed invention, because Elepano et al teach each of the preferred components within their requisite proportions for the purpose of removing paint from the skin and one skilled in the art would expect similar characteristics.” Applicant respectfully disagrees with the Examiner’s assertions and traverses these rejections as they may be considered in connection with the present claims.

As noted by the Examiner, Elepano describes a paint remover for removing paint from skin that may contain 10-40% propylene carbonate along with other components. Applicant respectfully submits that this reference is inapplicable to the present claims, which specify that the composition contains 85% to 98% by weight propylene carbonate, a range much higher than that indicated in Elepano. As a result, the present claims are contrary to the teachings of the Elepano patent. Therefore, Applicant requests that the rejections over Elepano be reconsidered and withdrawn.

The Examiner rejected claims 1-7, 9-14, and 19-20 under 35 USC §102(b), or alternatively under §103(a) as allegedly being anticipated by, or obvious over Wilkins et al., U.S. Pat. 5,215,675. The Examiner stated that Wilkins describes an aqueous stripping composition containing 1-50% water and 25-95% water soluble 4-10C ester, and that other components may be added. The Examiner asserted that Wilkins is anticipatory or in the alternative makes the claims obvious as Wilkins allegedly teaches each of the components in their requisite proportions. Applicant respectfully traverses these rejections as they may be considered in connection with the present claims.

In addition to the components cited by the Examiner, the paint strippers described in Wilkins also contain between about 1 and 30 parts by weight of peroxide (i.e., about 1-30% peroxide). (See, col. 2, lines 6-7.) The present claims specifically exclude peroxide from the claimed nail polish remover compositions. Thus, Wilkins neither anticipates nor suggests the present nail polish remover compositions. Applicant requests that the Examiner reconsider and withdraw the rejections over Wilkins et al.

The Examiner rejected claims 1-3, 5-7, 9, 11-20, and 22-26 under 35 U.S.C. §102(b), or alternatively under §103(a) as allegedly being anticipated by, or obvious over Stevens U.S. Pat. 5,098,591. The Examiner stated that Stevens discloses a paint stripping composition that includes 10-60% by weight of a low boiling point VOC such as N-methyl pyrrolidone, 15-5% by weight of a solvent, 5-60% by weight of solvent such as ethylene carbonate, propylene carbonate or mixtures thereof, 0-45% by weight of water and a thickening agent, citing to col. 3, lines 39-65. The Examiner further stated that Stevens specifically teaches that the composition has a pH of about 2 to 11. The Examiner asserted that Stevens is anticipatory or in the alternative are obvious because the reference teaches each of the components in their requisite proportions for the purpose of removing paint from a surface. Applicant respectfully traverses these rejections as they may be considered in connection with the present claims.

The present claimed invention is distinguished from the paint stripper described in Stevens by containing a substantially higher proportion of propylene carbonate, as well as by

being buffered to a mildly acidic range. The Examiner notes that Steven mentions a pH range of 2 to 11, thus allowing a range of pH from acidic to basic. However, specification of such a range is directly contrary to the present invention which specifies that the nail polish remover composition is buffered to a range of pH 2 to 6, i.e., an acidic pH, specifically excluding neutral and basic pH's. The broad range mentioned in Stevens, which refers to unbuffered pH values and including as it does a pH range that is directly contrary to the present invention, neither describes nor suggests the narrower, advantageous buffered pH range specified in the present claims.

As a result, Steven cannot anticipate any of the present claims. Further, there is nothing in Steven to suggest the presently specified high proportion of propylene carbonate and the buffered acidic pH range. Therefore, Applicant respectfully submits that the rejections over Stevens are inapplicable to the present claims, and requests that the Examiner reconsider and withdraw these rejections.

The Examiner also rejected claims 1-26 under 35 U.S.C. §103(a) as being unpatentable over Marquis et al. U.S. Pat. 6,586,380 in view of Stevens, U.S. Pat. 5,098,591 (discussed in the prior rejection). The Examiner stated that Marquis discloses a paint removing composition that includes 10-90% by weight of an alkylene carbonate and 0.1 to 25% water, as well as other components. The Examiner further states that Marquis is silent with respect to pH, but states that Stevens is relied on as set forth in the rejections over Stevens, and it specifically discloses a pH of 2-11. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to include a pH within the range of 2-6 because Stevens suggests said range for paint stripping and further teaches that surprising results have been obtained by having a pH within the range of 5.5-8. Applicant respectfully traverses these rejections as they may be considered in connection with the present claims.

Preliminarily, the Examiner has not provided any reason why a person of ordinary skill in the art would combine Marquis et al. with Steven in any way. Applicant discerns no reason for

such combination, and the absence of any reasoning by the Examiner explaining the basis for such combination is contrary to controlling case law and is therefore improper.

In addition, even if combined, Marquis and Stevens do not lead to the present invention for at least two reasons as explained below. In any such combination, the cited references must be considered in their entireties; it is again improper to pick and choose particular components to lead to the claimed invention without a basis for doing so. In the present case, Stevens stated that preferred compositions generally have a neutral pH (col. 8, lines 55-58), but that a number of embodiments have a pH within the range of about 5.5 to about 8.0 and preferably within the range of about 6.0 to about 8.0. (col. 8, lines 63-66) Notably, this assertion did not generalize any pH ranges to paint strippers in general, or even to all the paint stripper compositions described in Stevens. Instead, the statement was limited to “a number of embodiments.” There is no suggestion in Stevens that the pH of any composition should be adjusted to the particular pH range of 5.5 to 8.0 or 6.0 to 8.0 and no suggestion to buffer the composition in either of those ranges; instead it appears that those are merely the natural result of mixing the components in certain embodiments. As a result, there is no reason why a person of ordinary skill in the art would select the limited mention of pH in the range of about 5.5 to about 8.0 or any other pH mentioned in Stevens and apply it to any other composition, and in particular, no reason why such a person would apply it to the composition of Marquis et al. There is simply not any generalizable suggestion or motivation, or any other reason that would lead a person of ordinary skill in the art to modify the composition of Marquis in the manner suggested by the Examiner.

In connection with Marquis’ express requirement for the inclusion of peroxide, the present claims exclude peroxide; it is unsuitable for the present nail polish removers. Thus, even if particular pH ranges from Stevens were imported into the composition of Marquis, the result does not lead to the present claimed invention because of the inclusion of peroxide in the Marquis paint removers.

In summary, there is no reason why a person of ordinary skill in the art would combine Marquis et al. with Stevens, and, even if such a reason existed, the combination does not lead to

the present invention. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections.

In view of the amendments and discussion above, Applicant respectfully submits that the present claims are allowable, and request notice to that effect.

No additional claim fee is due in connection with this submission. Claim fees were previously paid for 32 claims, including 4 independent claims, all of which are now cancelled. Therefore, no additional claim fees are due for the 26 claims, including 2 independent claims submitted herein.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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